

## REMARKS

### **Claim Objections**

The applicant herein amends claim 1, and submits that the claim amendment cures the Office's objection. The applicant respectfully requests that the Office withdraw its objection.

### **Claims Rejections - 35 USC §112 Second Paragraph**

The Office rejected Claim 15 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The applicant has amended claim 15 to clarify that the "laid rigidly" means to cement. The applicant respectfully submits that this cures the Office's rejection, and requests that the Office's rejection be withdrawn.

### **Claim Rejections – 35 USC § 103**

The Office has quoted the statute from 35 USC 103(a), which is referenced herein. The Office has rejected claim 1-23 as being unpatentable over EP Patent EP0386324 issued to Siplast GMBH in view of other references. Applicant has carefully considered the Office rejections and respectfully submits that the amended claims, as supported by the arguments herein, are distinguishable from the cited reference.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 USC §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;

2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

In contrast to the claimed invention the ‘324 reference is in no way a layer construction with a decoupling and insulation system but only a bonding agent for laying tiles in a thin bed without any decoupling feature. The plate according to the ‘324 reference therefore comprises a cold-setting bituminous layer (1) whose underside durably adheres to the substrate (4, 5) and whose top side is coated with a further layer with a relief structure. This further layer is made of two layer portions durably connected together, the lower portion made of a fleece or a fabric or a foil and applied as a coating to the top side of the bituminous layer while the upper layer portion comprises a mesh. Such a plate is used for insulating walls in a bath or the like against penetration of water and to ensure the safe fastening of the tiles to the wall. The layer with a relief structure is made for ensuring a better connection between tiles and underground because on the bituminous layer the tiles can not be fastened directly.

There is no suggestion to use such a wall plate (see Figure 2) as a plate for laying on the ground where a decoupling function may be needed. A decoupling function used with a plate according to the ‘324 reference would lead to loosening or dislodging of the plate and the connected tiles will fall down from the wall. So the **durable** connection between the wall and the plate must be ensured by means of the cold-setting bonding and therefore there is no possibility to use it as a decoupling plate in the sense of the patent application. The ‘324 reference is therefore only a document that describes the background of the invention but is not really relevant.

The applicant respectfully submits that if one examines the layer construction described in the ‘324 reference, this layer construction also is not comparable with the one of the claimed invention. The applicant respectfully submits that the Office is incorrect in his opinion that the sealing layer is composed of either a non-woven or woven fabric or a film. In contrast to the claimed invention only sealing layer, that can be alleged in the ‘324 reference is the cold-setting

bituminous layer 1 which seals the underground in a well known way because of the properties of the bituminous sealing layer 1. On top of this bituminous layer there is a layer 3a composed of either a non-woven or woven fabric or a film which has the only task to be durably fastened to the bituminous layer 1 and to ensure a strong contact between the bituminous sealing layer 1 and the tiles respective layer 3b. In contrast to the claimed invention, the lattice type reinforcement layer 3b is fastened only to the layer 3a and not to the bituminous sealing layer 1. Therefore, the layer 3a has a contact to the bituminous sealing layer 1 on nearly its whole lower surface and the reinforcement layer 3b is fastened to the layer 3a only at several points so that the filler material can wrap around the lattice structure of the reinforcement layer 3b. The layer 3a itself can not be used for ensuring the strong contact between the filler material and the layer construction because the layer has no space for being filled by the filler material. The absence of a reinforcement function of layer 3b, in contrast to the claimed invention, can be seen in Figure 2 of the '324 reference where it is shown that the filler material do not fill the holes of the layer 3b since in the cross section of Figure 2 the lattice elements are only on the very back side of the thick layer formed by the filler material. The applicant respectfully submits that the '324 reference, in contrast to the claimed invention can not be understood in a way in which the filler material is **incorporated** in the anchoring layer.

In contrast to the cited references, the claimed invention provides a very stiff or rigid layer construction for laying tiles that has both a sealing and a decoupling function. The stiffness is facilitated by providing a layer that can accommodate a sufficient amount of the filler material. In particular, because of the anchoring layer that is disposed on top and the reinforcing layer which is also laid on top of and secured to it, it is ensured that joint mortar that is applied to the top face bonds completely with the decoupling and sealing system, thereby ensuring appropriate load-bearing capacity for the decoupling and sealing system. The lattice-type structural element permits particularly simple construction of the anchoring layer that essentially determines the thickness of the decoupling and sealing system. The sealing layer ensures appropriate liquid-impermeable sealing against the substratum at the installation site, and also ensures mechanical decoupling in the case of floating installation. As it is said in the description (page 9 of the translation) the

“significant advantage for the utilization properties of the decoupling and sealing system according to the present invention that, after the installation of the filler material, the anchoring layer is essentially completely filled with filler material and the reinforcing layer that is embedded in the hardened filler material performs a stiffening and reinforcing function for dispersing mechanical loads that are introduced from above, with the result that load dispersal is possible through significantly greater layer thicknesses than is the case with known decoupling and sealing systems since, in addition, the whole layer thickness of the anchoring layer helps to bear the loads and, at the same time, is reinforced by the reinforcing layer.”

The applicant respectfully submits that the ‘324 reference, therefore, can not be understood in the way alleged by the Office.

The Office, also cites US Patent No. 5,238,721 issued to Nakazawa. The ‘721 reference, in contrast to the claimed invention fails to disclose an anchoring layer as in the claimed invention. The Office relies upon the ‘721 reference to disclose a reinforcement layer.

In the ‘721 reference the alleged reinforcement layer 5 fails to provide the properties of the reinforcement needs met by the claimed invention. The mesh of the ‘721 reference provided a special elasticity because the core material 51 made of glass fibers or the equivalent is covered by a layer of rubber or similar substance. This rubber provides desired elasticity for laying the tiles on top of a coating layer 52. Therefore, a reinforcement function of this layer is not disclosed and cannot be inferred.

The applicant respectfully submits that the Office is mistaken when it alleges that the layer 52 of the ‘721 reference combined with a layer system according to the ‘324 reference would arise by adhering the layer 52 with the filler material. It is an important feature of a reinforcement layer that the reinforcement layer is fastened to the anchoring layer before filling in the filler material. Otherwise, the strength of the contact between reinforcement layer and

anchoring layer is limited to the strength of the filler material. This strength may be less than a contact made by sticking or welding them together. The layer 52 is not fastened to a layer on the underground in a manner comparable to the claimed invention.

The cited US Patent No. 6171015 and French Patent No. 2774715 equally fail to disclose an anchoring layer configured to receive a settable filler in contact with a lattice-type structure. In all cited documents the anchoring elements or reinforcement elements are only covered by a thin material layer which has itself no stiffness and can not work as a load dispersal for loads coming from above the layer arrangement.

As the cited references, either alone or in combination fail to disclose the invention of claim 1 and those claims dependant therefrom, the applicant respectfully requests that the Office withdraw its rejection of claims 1-23.

### **Double Patenting**

#### ***Terminal Disclaimer for Non-Statutory Double Patenting***

The Office issued a provisional Double Patenting rejection, and Applicant agrees to herein file a terminal disclaimer to advance processing and obviate the rejection based on non-statutory double patenting. The filing of the terminal disclaimer is **not** an admission of the propriety or merits of the rejection. The issued patent and the above-referenced application share common ownership. Review and allowance is respectfully requested.

The Office provisionally rejected claims 1-8, 11-17, and 20-24 under the judicially created doctrine of obviousness-type double patenting over U.S. Patent Application No. 10/595,695. Applicant agrees to a terminal disclaimer only to advance processing of the present application and states herein that the cited U.S. Patent Application No. 10/595,695 and the above-referenced application share common ownership.

A rejection based on a nonstatutory type of double patenting is obviated by filing a terminal disclaimer in the application or proceeding in which the rejection is made. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Knohl, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and In re Griswold, 365 F.2d 834, 150 USPQ 804 (CCPA 1966)

It should be understood the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is **not** an admission of the propriety of the rejection. Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

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